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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184529
Party	Plaintiff Georgia-Pacific Consumer Products LP
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Date	02/19/2009
Attachments	GAPA v. Global - Opposer's Response to Applicant's Motion to Compel with Exhibit A.pdf ( 15 pages )(90246 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529  
Serial No.: 77/364,616

**OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO COMPEL**

OPPOSER GEORGIA-PACIFIC CONSUMER PRODUCTS LP ("Georgia-Pacific")

responds to Applicant's Motion to Compel, showing as follows:

**I. Applicant's Motion to Compel should be Denied Pending Georgia-Pacific's Motion to Amend the Protective Order.**

Applicant's Motion to Compel is premature and unnecessary, as Georgia-Pacific has never refused to produce responsive documents and, as Applicant admits in its Motion, has already produced all non-confidential documents responsive to Opposer's Requests. As set forth previously in its Motion for Protective Order, Georgia-Pacific has only refrained from producing its confidential documents until such time as the Board resolves the pending dispute between the parties regarding the terms of the Protective Order. Thus, Georgia-Pacific's withholding of confidential documents is not for the purpose of unjustifiable delay, but because of a legitimate dispute over how such documents will be treated by Applicant's counsel and Applicant.

Moreover, Applicant's Motion to Compel is disingenuous because, while Georgia-Pacific has produced all of its non-confidential documents in response to Applicant's document requests, Applicant has failed to produce any documents to Georgia-Pacific – not even the non-

confidential ones – even though such documents were due to be produced back in November 2008. Applicant has not provided any reason why it failed to produce at least the non-confidential documents in its possession.

Once the Board resolves the issue of the protective order, Georgia-Pacific promptly will produce its confidential responsive documents, rendering Applicant's Motion to Compel entirely moot. In short, because both parties are withholding their production of certain documents until the pending protective order motion is resolved, the Board should first address the protective order issue and then deny Applicant's Motion to Compel as moot.

## **II. The Board's Standard Protective Order is not Mandatory and the Board should Enter the Amended Protective Order Proposed by Georgia-Pacific.**

As discussed in Georgia-Pacific's Motion for Protective Order, the Board permits modifications to its standard protective order. There is no merit to Applicant's contention that Opposer "must satisfy a heavy burden of proof" in order to modify the standard protective order. Even the rule cited by Applicant refutes this notion, as it clearly states that the parties are free to modify the standard protective order. *See* 72 Fed. Reg. 42242, 4224 (Aug. 1, 2007). There is nothing in the new Board rule that requires a heightened burden of proof to modify the terms of the standard protective order.

In fact, the Board recently issued an opinion in a separate Opposition proceeding to which Georgia-Pacific is a party,<sup>1</sup> in which it approved of a protective order with an identical provision allowing in-house counsel access to all levels of confidential information. *See* Order of February 13, 2009, attached hereto as **Exhibit A**. In this decision, the Board rejected the same argument Applicant makes in its motion that the Board's standard protective order is required, stating:

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<sup>1</sup> That Opposition is styled as *Georgia-Pacific Consumer Products, LP v. Kruger Products Limited*, Opposition No. 91168077.

[W]hen the Board first promulgated the standard protective order in 2000 the announcement specified that the order was one which parties were free to adopt or to modify. *See Official Gazette*, 1235 TMOG 70 (June 20,2000). In its new rules effective August 31, 2007, the Board made the standard protective order applicable to all cases. *See* “Miscellaneous Changes to Trademark Trial and Appeal Board Rules,” 72 Fed. Reg. 42242, 42244 (Aug. 1, 2007). The announcement of the new rule noted that “As under current practice, parties are free to agree to modify the standard protective order.” *Id.*

*See* Exhibit A, at 4. The Board permitted the protective order to include the same provision that Georgia-Pacific seeks in this matter to permit its in-house counsel access to all levels of confidential information and denied the Applicant’s request to enter the Board’s standard order instead. *See id.* at 6. In reaching this decision, the Board found that there was no evidence of “any increased danger of inadvertent disclosure” if in-house counsel was permitted access to confidential information and documents. *See id.* at 5 (citing *U.S. Steel Corp. v. U.S.*, 730 F.2d 1465, 1469 (Fed. Cir. 1984)).

The “risk of inadvertent disclosure” is the proper standard from *U.S. Steel* that the Board should apply here as well. *See U.S. Steel*, 730 F.2d at 1468-69. The Federal Circuit in that case determined that access to confidential information could only be denied where “an unacceptable opportunity for inadvertent disclosure exists,” which “must be determined...by the facts on a counsel-by-counsel basis, and cannot be determined solely by giving controlling weight to the classification of counsel as in-house rather than retained.” *Id.* at 1468. Although it did not set a bright-line rule, the Federal Circuit found that a request might properly be denied in a case “where in-house counsel are involved in competitive decision-making.” *Id.* It defined “competitive decision-making as “shorthand for a counsel’s activities, association, and relationship with a client that are such as to involve counsel’s advice and participation in any or all of the client’s decision (pricing, product design, etc.) made in light of similar...information about a competitor.” *Id.* at n. 3.

Georgia-Pacific has shown in its supporting affidavits that Ms. Boss and Ms. Cason do not engage in this type of decision-making, and that there is no heightened risk that they would inadvertently disclose Applicant's confidential information. Applicant misinterprets the *Matsushita* case as requiring Georgia-Pacific to make a more detailed factual showing regarding the activities of Ms. Boss and Ms. Cason. Their affidavits mirror the affidavit submitted by the General Counsel seeking access in *Matsushita*, in that they aver that (1) their responsibilities are legal in nature, *see* Boss Dec., ¶ 4; Cason Dec., ¶4; (2) they do not engage in decisions relating to the pricing, marketing, or technical design of Georgia-Pacific's products, *see* Boss Dec., ¶ 6; Cason Dec., ¶6; and (3) that any contact they make with the operating personnel at Georgia-Pacific is always in the context of legal issues and advice. Boss Dec., ¶ 7; Cason Dec., ¶ 7. *See Matsushita Elec. Ind. Co. v. U. S.*, 929 F.2d 1577, 1579-80 (Fed. Cir. 1991) (describing a similar affidavit submitted by the company's General Counsel seeking access to confidential information of a competitor in a legal dispute).

Finally, Applicant's contention that Georgia-Pacific's proposed protective order is only designed so that Georgia-Pacific can learn confidential information about a competitor is nothing but baseless aspersions for which Applicant provides no factual basis. All of the document requests complained of by Applicant seek documents relevant to the likelihood of confusion factors at issue in this Opposition. *See* Applicant's Motion to Compel, at 7-8. It is certainly common in an Opposition proceeding such as this that the parties would be competitors in similar industries and would request confidential business information from each other. Merely because Georgia-Pacific has requested confidential information does not mean that there would be a heightened risk of disclosure of such information beyond the legal team.

For these reasons, Applicant's Motion to Compel should be denied and Georgia-Pacific's Motion for Protective Order should be granted.

This 19th day of February, 2009.

/s/ Charlene R. Marino

R. Charles Henn Jr.

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Consumer Products LP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529

Serial No.: 77/364,616

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date, February 19, 2009, a copy of this paper has been served upon Applicant, by email and by U.S. mail, to Applicant's current identified counsel, as set forth below:

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/s/ Charlene R. Marino

Charlene R. Marino

# **EXHIBIT A**



UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

DUNN

Mailed: February 13, 2009

Opposition No. 91168077  
Cancellation No. 92045449  
Cancellation No. 92045451

Georgia-Pacific Consumer  
Products LP

v.

Kruger Products Limited

**Elizabeth A. Dunn, Attorney (571-272-4267):**

This consolidated case comes up on the motion of applicant/respondent Kruger Products Limited (hereafter, applicant), filed October 7, 2008, to modify the stipulated protective order filed by the parties and approved by the Board, and the motion of opposer/petitioner Georgia-Pacific Consumer Products LP (hereafter, opposer), filed October 8, 2008, to compel production of confidential discovery responses under the terms of the stipulated protective agreement. Both motions are contested.

As background the Board notes that these proceedings have been pending since late 2005 or early 2006, that each

proceeding involves a claim of priority and likelihood of confusion between the flower design marks used by the parties on bathroom tissue, and that the consolidated proceeding has largely been suspended by party stipulation approved by the Board to allow settlement negotiations. On April 17, 2007, the Board approved the parties' stipulated protective order, signed by counsel for both parties, which provides that specified in-house counsel would be provided access to the confidential information defined within the agreement.

**APPLICANT'S MOTION TO MODIFY STIPULATED PROTECTIVE ORDER**

Pursuant to Trademark Rule 2.120(f), applicant moves the Board for modification of the stipulated protective order negotiated by the parties and approved by the Board because it is overly broad, does not recognize the categories of confidential information established by the Board in its standard protective order, and because "access to [] trade secret/commercially sensitive information should be limited to outside counsel of [opposer] in order to protect [applicant's] business." Applicant cites the Board's primary reviewing court for the proposition that, while status as in-house counsel cannot serve as the sole basis for denial of access, the disclosure of confidential information to in-house counsel involved in competitive

decisions-making may be restricted. See *U.S. Steel Corp. v. U.S.*, 730 F.2d 1465, 1469 (Fed. Cir. 1984).

In opposing the motion, opposer points out that use of the Board's standard protective order is not mandatory, that opposer deliberately negotiated the provision allowing access by its specified in-house counsel, that the provision remains important to opposer, and that applicant presents no arguments why it should be released from the agreement it entered voluntarily, while represented by counsel, more than nineteen months ago.

The Board finds that applicant has failed to demonstrate any reason why applicant should not remain bound by the stipulation negotiated by the parties. The scheme for the protection of confidential information set forth in the Board's standard protective order does not establish a required level of protection, and the case cited by applicant does not establish a per se rule but finds that the need to restrict access of in-house counsel to confidential information varies under different circumstances. *U.S. Steel Corp. v. U.S.*, at 1469 ("We hold only that status as in-house counsel cannot alone create that probability of serious risk to confidentiality and cannot therefore serve as the sole basis for denial of access").

With respect to the provisions for protecting information in the Board's standard order, when the Board first promulgated the standard protective order in 2000 the announcement specified that the order was one which parties were free to adopt or to modify. See Official Gazette, 1235 TMOG 70 (June 20, 2000). In its new rules effective August 31, 2007, the Board made the standard protective order applicable to all cases. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42244 (Aug. 1, 2007). The announcement of the new rule noted that "As under current practice, parties are free to agree to modify the standard protective order." *Id.* The fact that the Board's standard protective order establishes different criteria for the protection of confidential information does not invalidate the criteria to which the parties stipulated.

Applicant's argument that the stipulated protective order should be modified to protect applicant's business does not set forth any unforeseen circumstances which would warrant modification. Applicant wishes to restrict the access of in-house counsel to "sensitive and proprietary business information including, but not limited to, sales revenue and advertising expenditures." The parties' negotiated agreement defines confidential information (§5) and provides as examples "information regarding ... marketing,

sales ... and other expenditures of the producing party" and defines who has general access to the confidential information (§14) with a listing that includes (§14(c)) "To counsel for a party ... Counsel for a party also includes designated in-house legal representatives of the parties, specifically Emily K. Breslin and Christine M. Cason for Opposers and Oxana Iatsyk for Applicant, and their successors." Plainly, the parties anticipated that sales and advertising information would be covered by the stipulation, and also anticipated access to that information by the same in-house counsel that applicant now seeks to bar.

Applicant's motion does not refer to any intervening facts which would increase the sensitivity of the information beyond that which was present at the time the terms of the stipulation were negotiated, and does not argue that there is any increased danger of inadvertent disclosure. *U.S. Steel Corp. v. U.S.*, at 1469. ("In further proceedings, access should be denied or granted on the basis of each individual counsel's actual activity and relationship with the party represented, without regard to whether a particular counsel is in-house or retained.").

As a final point, both the Board and the parties benefit from reduced areas of dispute, and as a result the Board has long encouraged the parties to Board proceedings

to ease the litigation process with stipulated agreements on the protection of confidential information.<sup>1</sup> *Neville Chemical Co. v. The Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) ("The Board has encouraged signature of stipulated protective orders by both parties and their attorneys so that they shall all be bound by the terms thereof.").

Because applicant has failed to support its motion for modification, applicant's motion is denied, and the stipulated protective agreement between the parties remains in effect.

#### OPPOSER'S MOTION TO COMPEL

Opposer moves the Board to compel applicant to produce all confidential discovery responses pursuant to the parties' stipulated protective order. Because opposer's motion does not include the contested discovery requests, the motion to compel is denied for failure to comply with Trademark Rule 2.120(e)(1) ("A motion to compel discovery shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy

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<sup>1</sup> Civil litigation also encourages stipulations between the parties, and requires subsequent compliance. See *FTC v. GlaxoSmithKline*, 294 F.3d 141, 146 (D.C. Cir. 2002) (court finds stipulation binding based in part on "the implausibility of the idea that parties would establish elaborate procedures to narrow their dispute through negotiation with the foreknowledge that their adversary might again expand the dispute before the [] court.").

**Opposition No. 91168077 (parent)**

of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying." ).

**SCHEDULE RESET**

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date of this order to respond to any outstanding discovery requests. Discovery and trial dates are reset below.

DISCOVERY PERIOD TO CLOSE:	<b>April 3, 2009</b>
Thirty-day testimony period for party in position of plaintiff to close:	<b>July 2, 2009</b>
Thirty-day testimony period for party in position of defendant to close:	<b>August 31, 2009</b>
Fifteen-day rebuttal testimony period to close:	<b>October 15, 2009</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>